



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/925,836	08/07/2001	William F. Scholz	46991/GTL/A23	5259

7590 01/16/2004  
GRANT T. LANGTON, ESQ.  
JEFFER, MANGELS, BUTLER & MARMARO LLP  
1900 AVENUE OF THE STARS  
7TH FLOOR  
LOS ANGELES, CA 90067-4308

EXAMINER

AHMAD, NASSER

ART UNIT	PAPER NUMBER
1772	

1772

DATE MAILED: 01/16/2004

20

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

<b>Application No.</b> 09/925,836	<b>Applicant(s)</b> SCHOLZ ET AL.	
<b>Examiner</b> Nasser Ahmad	<b>Art Unit</b> 1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1)  Responsive to communication(s) filed on 24 October 2003.
- 2a)  This action is FINAL.
- 2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4)  Claim(s) 38-43 and 45-56 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5)  Claim(s) 38-42, 45 and 49 is/are allowed.
- 6)  Claim(s) 43, 46-48 and 50-56 is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a)  The translation of the foreign language provisional application has been received.
- 14)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1)  Notice of References Cited (PTO-892)
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5)  Notice of Informal Patent Application (PTO-152)
- 6)  Other: \_\_\_\_\_

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 23, 2003 has been entered.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 43, 46-48 and 50-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Samonides in view of McNaul

Samonides relates to a method of forming a pressure sensitive adhesive (PSA) construction. The method comprises the steps of applying a layer of PSA to a release coated surface, applying a plurality of printed indicia thereon and providing an overlamine film on the indicia (col.3, lines 35-68). The mixture is extruded at 50 to 150 F. The method further comprises heating the overlamine before it laminating step as it is being extruded. However, Samonides fails to teach the presence of a film material applied to the adhesive surface before the printing of indicia. McNaul discloses a

Art Unit: 1772

subsurface printable laminate wherein the adhesive is provided with a film having printable surface, printing indicia onto the film surface, heat-drying the indicia, and then laminating a protective clear film thereover (col. 4, lines 8-25). McNaul teaches the advantage of using a printable film surface between the adhesive and the indicia for providing an aesthetically pleasing surface and providing protection from the adhesive composition. Therefore, it would have been obvious to one having ordinary skill in the art to utilize McNaul's teaching of providing a film layer between the adhesive and the printed indicia in the invention of Samonides with the motivation to provide aesthetically appealing backing surface and protecting the indicia from the oil contamination which seeps from the adhesive layer.

The film materials' viscosity and the application temperature would have been obvious to one having ordinary skill in the art based on optimization through routine experimentation because the applied art utilizes the same material.

#### ***Response to Arguments***

4. Applicant's arguments filed October 24, 2003 have been fully considered but they are not persuasive.

Applicant argues that in claim 43, the non-final state of the PSA "is at the point the PSA being applied and is not at the point of any subsequent film-forming material being applied to the PSA". This is not found to be convincing because said phrase could not be located in the claims and cannot be read thereinto for the purpose of avoiding

Art Unit: 1772

applied prior art. Applicant is requested to direct to specific sections in the specification as originally filed for support for said phrase.

Contrary to applicant's allegation, Samonides teaches the application of the film-forming material onto the PSA when the PSA is in the non-final state. This is because the PSA is not fully cured at the film-applying stage, because the PSA continues to cure after it is applied with the film material, and because there is no showing as to the boundary between the non-final and the final cured state of the PSA by the applicant.

Regarding the McNaul reference, applicant should note that it was cited to show that the presence of a film forming layer between the adhesive and the printed indicia is well known and obvious in the art. Further, in response to applicant's piece-meal analysis of the references, it has been held that one cannot show non-obviousness by attacking the references individually where, as here, the rejections are based on combination of references. *In re Keller*, 208 USPQ871 (CCPA 1981).

In response to applicant's argument about the obviousness rejection under 35 U.S.C.103(a), please note that regarding the step of applying the film-forming material when the PSA layer is in the non-final state, the above grounds of explanations apply a fortiori to this argument.

As for claim 46, applicant argues that all the steps are carried out during a continuous process. This is not found to be persuasive because Samonides clearly teaches that the process is a continuous process. In response to applicant's allegation that McNaul does not disclose a continuous process as claimed, applicant is reminded

Art Unit: 1772

regarding the piece-meal analysis of the references by attacking the references individually as discussed herein above.

Thus, in the absence of any evidence to the contrary, it remains the examiner's position that the claimed invention would have been obvious over the prior art of record discussed above.

***Allowable Subject Matter***

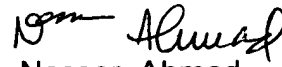
5. Claims 38-42, 45 and 49 are allowed.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is (703) 308-4424. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (703) 308-4251. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

  
Nasser Ahmad  
Primary Examiner  
Art Unit 1772

N. Ahmad.  
January 11, 2004.